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3   UNITED STATES PATENT AND TRADEMARK OFFICE

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6   BEFORE THE BOARD OF PATENT APPEALS

7   AND INTERFERENCES

8

9

10   Ex parte MARTIN PAGEL

11   —————

12

13   Appeal 2009-003102

14   Application 09/469,561

15   Technology Center 3600

16   —————

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19   Oral Hearing Held: August 13, 2009

20   —————

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23 Before MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI, and BIBHU

24 R. MOHANTY, Administrative Patent Judges

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26

27 ON BEHALF OF THE APPELLANT:

28

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34

35 The above-entitled matter came on for hearing on Thursday, August 13,

36 2009, at the U.S. Patent and Trademark Office, 600 Dulany Street,

37 Alexandria, Virginia, before Victor Lindsay, Freestate Reporting, Inc.

1   P R O C E E D I N G S

2

3   MR. LIVINGSTONE: My name is Wayne Livingstone and I'm an

4 associate involved in the prosecution of this current case on appeal which is

5 Application number 09/469,561. With me is Ross Viguet who has

6 supervised me in the prosecution of this case. And we both represent

7 Stamps.com, the real party of interest for this Appeal. The issues in this

8 case have been fully briefed, but I would like to explain to the Board some

9 of the distinctions between the art and the claims. So unless the Board has

10 any questions or comments at this time, I would like to proceed.

11   JUDGE CRAWFORD: I was wondering if you can explain what

12 extracting is?

13   MR. LIVINGSTONE: Okay, extracting is reviewing a data stream

14 and taking from that data stream information for later use.

15   JUDGE CRAWFORD: Okay. Is, is that somewhere defined in your

16 spec?

17   MR. LIVINGSTONE: It's not completely defined, but the way it's

18 used, it's clear that it's taking a subset of, of a data stream for further use.

19   JUDGE CRAWFORD: Okay, go ahead.

20   MR. LIVINGSTONE: Okay. I'd like to first go into the background

21 to the whole invention, and it relates to printer data (15) in the method. And

22 in completed base postage systems at the time of the invention, it becomes a

23 -- to prepare letter from mailing a user or a system operated for the user had

24 to first print the letter by sending a data stream to a printer and then

25 separately print the stamp on the envelope by sending another postage

26 indicia data stream to the printer.

1   In concert with this background, I would like to remind the Board that

2it was -- a long time ago it was -- the application was actually filed in 1999.

3From that background, the current -- this current application is close

4embodiment of the invention where, when printing a letter, a user sends a

5data stream from an application to print that letter, and from that very data

6stream data is extracted, and that extracted data is used to control additional

7functions such as the printing of the postage indicia.

8   Now, in the current rejection, we believe the Examiner's is not taking

9into account the differences between Harman, the cited reference, and the

10claimed invention. And I think the Examiner has also failed to show that

11Harman teaches all the limitations of the claims. For example, consider

12Claim 17 and 41, Claim 17 requires extracting includes examining the data

13stream for pre-established data patterns and wherein said pre-established

14data patterns include the beginning and ending of postage indicia data. So

15Claim -- has a similar limitation. Now, the Examiner asserts that this

16limitation is taught by the data patterns in job streams showing who they're

17to, if you could turn to Harman, Figure 2. In addition, the Examiner asserts

18that Harman's disclosure that unique separators separate job header (12)

19from other data. And that job header (12) -- data relating to postage indicia

20data, but job header (12) actually includes much more than postage indicia

21data. Harman, column 3, line 57 to 65, tells us that job header (12) includes

22data such as the number of document sheets to be accumulated for each mail

23team, whether or not a pre-printed insert has been added to the document

24sheets, the manner in which the accumulated sheets are to be folded, whether

25or not a metered return envelope is to be inserted into the envelope with the

26folded accumulation, and whether or not the mailed piece is to be moistened

1 or sealed. Clearly, job header (12) includes data apart from postage indicia

2 data. Therefore, the unique separators to which the Examiner refers do not

3 separate postage indicia data from other data because the unique separators

4 do not -- sorry, the unique separators do not teach the beginning and ending

5 of the postage indicia data because what it actually does those separators is

6 separate the job header (12) which includes a number of pieces of data

7 which I just referenced earlier, it cannot teach the beginning and ending of

8 postage indicia data. So, in sum, the Examiner has not shown that extracting

9 -- includes examining data patterns including beginning and ending of

10 postage indicia data. I think that's a very important distinction between

11 Claim 17 and 41 and the cited reference.

12   If, if it's okay, I can proceed to Claims 1 and 33.

13   JUDGE CRAWFORD: Go ahead.

14   MR. LIVINGSTONE: Okay. Claim 1 requires in a method of

15 printing a data stream being presented to a printer extracting data bits from

16 said data stream where said data stream is provided by an application which

17 has not been adapted to control the additional functions. The Examiner

18 relies on Microsoft Word which was disclosed in Harman as teaching the

19 application that provides the data stream. The Examiner also relies on the

20 parts of 112 for carrying all the extraction of the data stream. However, if

21 we examine Harman closely, we will see that Microsoft Word actually does

22 not provide the data stream that parts of 112 -- instead, as can be clearly seen

23 from Figure 3, if you can turn to Figure 3, Microsoft Word provides

24 documented, and it's important to know why he provides it, provides --

1   JUDGE CRAWFORD: Well, isn't -- doesn't the Examiner really

2 combine word processing application (30) and driver (37) to be the

3 application?

4   MR. LIVINGSTONE: Yes, he, he did assert that, that combination.

5 That combination, we believe, is antithetical to the explicit claim limitation

6 which says that the application is not -- has not been adapted to control the

7 additional functions. And if he makes that, that combination, you are

8 adapting Microsoft Word to, to control the additional functions. And that's

9 one of the disclosures we had in the specification is that you need not

10 modify the typical word processing program existing then to do what we are

11 claiming.

12   JUDGE CRAWFORD: Well, why, why do you say that the

13 combination of 30 and 37 doesn't meet the claim language about not being

14 adapted to control additional functions?

15   MR. LIVINGSTONE: Because we -- when, when claim -- driver (37)

16 is searching -- well, I mean driver (37) extracts address data. And if you use

17 -- and it includes, you know, provides information such as -- postage data,

18 all that, and I think in, in other parts you could, you could interpret that as

19 potentially controlling additional functions.

20   JUDGE CRAWFORD: Why?

21   MR. LIVINGSTONE: Because the information there that stored (38)

22 provides the driver (37) could be used to control additional functions. And,

23 you know, we don't believe it would be obvious to do it -- to make that

24 combination either because I, I don't think one skilled in the art -- to modify

25 a Microsoft Word application.

1   JUDGE CRAWFORD: Well, was he saying to modify or was he just
2 saying that we can just consider those two components, 30 and 37, to be the
3 application?

4   MR. LIVINGSTONE: But if you do that, it would be adapting to
5 control the additional functions.

6   JUDGE CRAWFORD: All right. Can you tell me whether or not
7 parser 112 is doing extracting?

8   MR. LIVINGSTONE: My understanding of the Examiner's rejection
9 is that the Examiner is interpreting parser 112 to do extracting. That aside,
10 let assume it does, our contention is what it is extracting is not what we are
11 claiming.

12   JUDGE CRAWFORD: Why?

13   MR. LIVINGSTONE: Because it's extracting a data stream that has
14 been -- it's actually a modified job data stream where Microsoft Word
15 provides document data. What happens in the Harman process is that the
16 document data is integrated with other data by driver 37 and may affect the
17 controller (4) resulting in job data and Figure 3 illustrates that. And if the
18 data stream from the center controller (4) that parser 112 actually parses and
19 that, that is our contention.

20   JUDGE CRAWFORD: Okay.

21   MR. LIVINGSTONE: And our further point is that parser 112
22 actually parses that integrated stream into, and this is important, into the
23 document data originally provided by Microsoft Word, the angle of data, and
24 mail finishing unit control data. And the basis of this is column 7, lines 44
25 to 66 in Harman. So -- you know, disclosure in Harman, we believe the

1 Examiner has mistakenly relied on a data stream that has not been provided

2 by the application, the Microsoft Word application, in, in his rejection.

3   JUDGE CRAWFORD: But I thought that the Examiner is saying that

4 30 and 37 is the application so the data stream that's provided to controller

5 (4) when controller (4) doesn't add the postal rates is the data from the

6 application when you consider 30 and 37 to be the application?

7   MR. LIVINGSTONE: We, we are arguing that the Examiner can't

8 make that combination, but just assume he does. After that, after the data

9 stream leaves that combination, it's also modified by mail sent to controller

10 (4).

11   JUDGE CRAWFORD: Well, how is it modified there?

12   MR. LIVINGSTONE: Postal rates and from -- as in 44, if you look at

13 Figure 3, that's added at mail center controller (4) in addition to material

14 information is also added at mail center controller (4).

15   JUDGE CRAWFORD: Well, I thought that the Examiner is saying

16 that in some circumstances Harman discloses that the postal rate can already

17 be put in before it even gets to controller 4 so that controller 4 would be a

18 pass-through?

19   MR. LIVINGSTONE: Yeah, our reading of that is that it would have

20 to be done at driver (37) which is another reason why if the postal rates are

21 added there, it's another reason why we're saying driver (37), adding driver

22 (37) to word, the word processing application is antithetical to our claim

23 language which says not adapted to --

24   JUDGE CRAWFORD: To control --

25   MR. LIVINGSTONE: Sorry --

26   JUDGE CRAWFORD: To control other functions, right?

1   MR. LIVINGSTONE: Correct. So, if you are adding postal rates,

2 postal indicia there, if you are, you are -- other functions. So, you know,

3 either way, we're running into problems with the claim language. And I

4 have not seen an embodiment in Harman that really could be read

5 reasonably to meet our claim language because if, if he -- if you assume mail

6 center controller (4) does not add postal rates, if you put it at driver (37), you

7 are, you are actually adding data that can be used to control the printing of

8 additional functions -- controlling additional functions. And, you know,

9 we're saying you -- in this, in this claim, you can start off with Microsoft -- I

10 mean a word application that's not adapted to --

11   JUDGE FISCHETTI: I have, I have question. You have a restrictive

12 limitation there.

13   MR. LIVINGSTONE: What?

14   JUDGE FISCHETTI: You have a restrictive limitation as I see it, the

15 non-adapted language. Is there, is there functionality or criticality that is

16 attributed to that limitation other than just saying we're not -- that application

17 does not have additional purposes?

18   MR. LIVINGSTONE: It is critical in the sense that the limitation

19 provides a real benefit to, to the user.

20   JUDGE FISCHETTI: Such as?

21   MR. LIVINGSTONE: Such as you have an application, you buy an

22 application, a word processor, off the shelf. You need not modify it to, to do

23 what we're claiming. And if you turn to page 5 of our disclosure, the third

24 paragraph, it states explicitly one important factor is that the output

25 generating software application running in the PC need not be modified. I

1 think that is -- at the time of the invention, which was 1999, that, that was a

2 critical feature, I think.

3   JUDGE FISCHETTI: One more question. You had the revised cert

4 upon claim differentiation if I, if I heard correctly for the, for the term

5 extraction. What claim was that where you were seeking that

6 differentiation?

7   MR. LIVINGSTONE: Claims 1 and 33, independent claims.

8   JUDGE FISCHETTI: Let me just get to 33.

9   MR. LIVINGSTONE: Once again, the question again?

10   JUDGE FISCHETTI: The -- you seem to be relying on the dependent

11 claim to define a term in the independent claim, the term being extraction --

12 extracting, rather.

13   MR. LIVINGSTONE: I tried to explain a term in the context of the

14 specification because the specification does not explicitly define extraction.

15 I think if we read it, the specification applies a whole new mean to extracting

16 in light of the specification. I think, you know, I think it would support what

17 I said earlier about extraction.

18   JUDGE FISCHETTI: So it looks like you have two, two independent

19 claims, one at 33 and you, you're trying to draw the definition from another

20 independent claim, namely Claim 33 and, and get that inference of definition

21 drawn into 1 is that what your argument was?

22   MR. LIVINGSTONE: I think what I was doing was in explaining, I

23 think I may have gone into an example, you know, because as I said, there's

24 -- explicit definition in the spec about extraction. So what I was trying to do

25 is interpret the word based on its natural, normal meaning and what the

26 specification discloses.

1   JUDGE FISCHETTI: Okay.

2   JUDGE CRAWFORD: No more question?

3   JUDGE MOHANTY: Your spec also -- can I go on?

4   JUDGE CRAWFORD: Yes.

5   JUDGE MOHANTY: I have a question. In respect --

6   JUDGE CRAWFORD: Can you hear him?

7   MR. LIVINGSTONE: Barely, I'm sorry.

8   JUDGE MOHANTY: In your specification at page 4, line 23, you say
9extract could also mean the entire document?

10   MR. LIVINGSTONE: Okay, that -- if you read the whole paragraph,
11it says in addition the, the extract could be the entire document. It could be
12sent to some destination. So, in addition to the extracting, that can be read to
13mean in addition to the extracting, you can send a whole document
14elsewhere.

15   JUDGE MOHANTY: Okay.

16   JUDGE CRAWFORD: Any other questions? We don't have any
17further questions. Could you hold on for just one minute?

18   MR. LIVINGSTONE: Sure.

19   JUDGE CRAWFORD: Excuse me, do you have his name and all
20that?

21   COURT REPORTER: Yes, I have that, thank you.

22   JUDGE CRAWFORD: Okay, that's it then.

23   MR. LIVINGSTONE: Okay, thank you very much for your time.

24   JUDGE CRAWFORD: Thank you, all right. Bye-bye.

25   (Whereupon, the hearing concluded on August 13, 2009.)